

08/687,292


**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

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08/687,292 07/25/96 SAIGH

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EXAMINER

ART UNIT

PAPER NUMBER

2315

16

DATE MAILED: 01/21/97

 This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 7/25/96 ☐ This action is made final.

 A shortened statutory period for response to this action is set to expire (3) month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133
**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/>   |

**Part II SUMMARY OF ACTION**
 1. ☒ Claims 1-11 and 18-36 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

 2. ☒ Claims 12-17 have been cancelled.

 3. ☐ Claims \_\_\_\_\_ are allowed.

 4. ☒ Claims 1-11 and 18-36 are rejected.

 5. ☐ Claims \_\_\_\_\_ are objected to.

 6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

 7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

 8. ☐ Formal drawings are required in response to this Office action.

 9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

 10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

 11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).

 12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

 13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

 14. ☒ Other - See attached.
**EXAMINER'S ACTION**

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15. Claims 1-11 and 18 remain for examination. Claims 19-36 are newly presented for examination.

16. The drawings are objected to because, in Fig. 1, suitable meaningful legends are recommended, **not just numerals**, for inadequately labeled drawings. See M.P.E.P 608.02 and 37 C.F.R 1.84(o). Correction is required.

17. Applicants are required to submit a proposed drawing correction in response to this Office Action. However, correction of the noted defect (formal drawing) can be deferred until the application is allowed by the examiner. Moreover, the applicant is reminded of the provisions of M.P.E.P 608.02(r) regarding separate letter of the draftsman.

18. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

20. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

21. Claims 1-11 and 18-36 are rejected under 35 U.S.C. § 102(a) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over the publication "The Heller Report" [Hereinafter, the publication]. This publication is submitted by the applicant and used in the parent case.

22. The publication discloses [e.g., see the whole report] the invention as claimed. Taking claims 1-11 and 18-24 as exemplary claims, the publication discloses a distribution system that offer users [e.g., students] a "rent"-or-buy option for electronic versions of textbooks with self-erase after a fixed time. In addition, the publication discloses the use of valid ID card in order for the user to download any number of available books at their local point of purchase from a large databank via satellite. These books will be downloaded only to those verified as users; each PIN-verified (Personal Identification Number) customer will have an electronic "signature" embedded in his or her copy at the POP [point of purchase], so that only his or her hardware device can read it; users renting or buying texts cannot make copies; and rental texts will be programmed to self-erase after a prefixed number of weeks or months.

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23. As to the feature of encryption of the information when the information is to be transferred, this feature is well within one of ordinary skill in the art at the time the invention was made.

24. As per claims 25-36, they are rejected as failing to teach or define the rejected claims 1-11 and 18-24 as discussed in paragraphs 28-33, supra.

25. Applicant's arguments filed 12/27/95 and 7/25/96 have been fully considered but they are not deemed to be persuasive.

In the remarks, applicants argues that:

(a) The item described in the Heller Report issue is a device capable of allowing the visual reading of information electronically stored on unique user memory units: "The item described in the present application is a unique system or network by which intellectual properties may be electronically transferred from the creator or owner to persons wishing to purchase the unlimited or limited use thereof in a fashion which reduces the risk of unauthorized or uncompensated use of the information being transferred. In reply, such argument feature is clearly taught in the Heller Report. See page 10 of Heller Report.

(b) The Parent Application was filed November 4, 1991. The Heller Report is dated October 1993. Thus, The Heller Report is not available as prior art under 35 U.S.C. § 102(b) and § 103 in the present application. In reply, first of all, the date of the Heller Report is prior to the filing of both Serial No. 08/296,120 and Serial No. 08/367,056. Secondly, the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made are unclear. Thirdly, the

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drawing of the Serial No. 08/367,056 and its disclosure are totally different from the parent application Serial No. 07/787,536.

(c) The Heller Report does not mention, describe, or suggest the encryption described and claimed in the present application. In reply, such feature of encryption of the information when the information is to be transferred is well within one of ordinary skill in the art at the time the invention was made.

26. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Krisna Lim** whose telephone number is (703) 305-9672. The examiner can normally be reached on Monday-Thursday from 7:30 AM to 4:30 PM. The examiner can also be reached on alternate Friday from 8:00 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Parshotam S. Lall, can be reached on (703) 305-9715. The fax phone number for this Group is (703) 308-5356.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

kl

January 16, 1997

  
KRISNA LIM  
PRIMARY EXAMINER  
GROUP 2300